

REMARKS

Claims 1-10 and 15-19 are elected for prosecution in the present application.

Claims 11-14 are withdrawn.

The indication of allowable subject matter over the prior art in claims 2-5 and 10 is noted and appreciated. New claim 15 corresponds to allowable claim 2/1 written in independent form without amendment. Claim 3 is amended to depend from new claim 15.

New claim 16 corresponds to allowable claim 4/1 without amendment.

New claim 17 corresponds to allowable claim 5/1 without amendment.

New claim 18 corresponds to allowable claim 10/9/1. The recitation in claim 18 taken from claim 9 has been amended to refer to "a coil compression valve spring" to lay foundation for the recitation of "valve spring" later in the claim, to which the Examiner has objected under 35 USC 112(2).

Thus, new claims 15-18, together with dependent claim 3, are allowable in view of the Examiner's indication of allowable subject matter over the prior art in claims 2-5 and 10 as filed.

Dependent claim 9 has been amended to refer to "a coil compression valve spring" to lay foundation for the recitation of "said valve spring" at line 4 of the same claim. This addresses the Examiner's objection to claim 9 under 35 USC 112(2).

The Examiner has rejected claims 1 and 6-9 as allegedly being "anticipated" by Hiranuma 5,582,204. It is axiomatic that, in order to "anticipate" a claim, "all the elements in the claim (or possibly their equivalents...) must have been disclosed in a single prior art reference or device." *Radio Steel & Mfg. Co. v. MTD Products, Inc.*, 731 F.2d 840, 845, 221 U.S.P.Q. 657, 661 (Fed. Cir. 1984). Moreover, "it is incumbent upon the

Examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference.” *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1462 (BPAI 1990). If anticipation is based upon alleged inherency, such alleged inherency must be certain, and cannot be established by probabilities or speculation. *Ex parte Cyba*, 155 U.S.P.Q. 756 (POBA 1967); *Ex parte Keither*, 154 U.S.P.Q. 320 (POBA 1967).

Independent claim 1 is directed to a method of assembling a check valve into a tube of deformable material, in which the first step (a) recites “expanding” an end portion of the tube. The word “expanding” means to open up or increase in size. There is no such step disclosed or suggested in Hiranuma. Indeed, there is no description whatsoever how plug 21 (FIG. 4) is made. The sheet 25 is made by “reducing” the end of the plug (column 2, line 56), but there is no suggestion of expanding the end of the plug, to receive the ball 72 or otherwise. The arrows in FIG. 4 of Hiranuma relate to airflow through the holes 10 (column 2, line 38), and not to expansion of the end of the plug 21. Thus, claim 1 clearly is not “anticipated” by the Hiranuma reference.

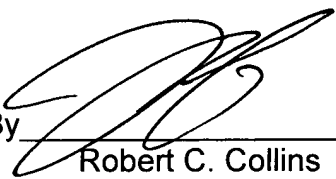

New dependent claim 19 recites that, prior to the “expanding” step (a), the method includes the step of providing the tube having the end portion of uniform wall thickness, as clearly shown in application FIG. 2A. This further distinguishes over Hiranuma, in which the end of the plug 21 (FIG. 4) is decidedly of non-uniform wall thickness.

It therefore is believed and respectfully submitted that all elected claims 1-10 and 15-19 are allowable at this time, and favorable action is respectfully solicited.

Please charge any fees associated with this submission to Account No. 50-0852.

Respectfully submitted,

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